

REMARKS

In the Office Action¹, the Examiner:

rejected claims 30-54 under 35 U.S.C. § 101 as allegedly drawn to non-statutory subject matter;

rejected claims 30, 31, and 36-55 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 7,254,558 to Hinkle et al. ("*Hinkle*"), in view of Special Edition, Using Microsoft Excel 97, Bestseller Edition by Bruce Halberg et al., October 1997 ("*Excel97*"), and U.S. Patent No. 6,989,820 to Baker et al. ("*Baker*"); and

rejected claims 32-35 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hinkle*, in view of *Excel97*, *Baker*, and U.S. Patent No. 6,718,535 to Underwood ("*Underwood*").

Applicant amends claims 30, 31, 36, 38, 40, 45, 54, and 55, and cancels claims 32-35, 37, 39, 42-44, and 46-48 without prejudice or disclaimer. Claims 30, 31, 36, 38, 40, 41, 45, 46, and 49-55 are now pending in this application, and the rejections of claims 32-35, 37, 39, 42-44, and 46-48 are rendered moot by their cancellation.

Initially, Applicant notes that the rejection of claim 36 appears to be based on an unidentified reference. Page 5 of the Office Action states that "it would have been obvious to one skilled in the art at the time of the invention to modify *Hinkle*, *Baker*, and *Excel97* with *RtOff2*" (emphasis added). The Examiner concedes that combinations of *Hinkle*, *Baker*, and *Excel97* do not teach or suggest "selecting, from the plurality of invoices, invoices having a balance that is smaller than a preselectable second value and larger than a preselectable third value; and wherein the second value

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

is smaller than or equal to the first value and the third value is smaller than the second value," as recited in claim 36. Office Action, p. 5. The Examiner fails to identify any reference that allegedly discloses or suggests these features. For at least these reasons, it is requested that the rejection of claim 36 be withdrawn, and that the claim be allowed. In the event that Applicant's response to this Office Action does not result in an allowance, Applicant requests clarification as to the intended source of this reference and respectfully requests that the next Office Action be non-final, to allow Applicant to fully consider and respond to each rejection.

Applicant respectfully traverses the rejection of claims 30, 31, 36, 38, 40, 41, 45, 46, and 49-54 under 35 U.S.C. § 101. The *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, Docket No. PTO-P-2010-0067, as published by the U.S.P.T.O. in the Federal Register on July 27, 2010, "provides factors to consider in determining subject matter eligibility of method claims," and states that the machine-or-transformation test "is not the sole test for deciding whether an invention is a patent-eligible 'process.'" Quoting *Bilski v. Kappos*, 561 U.S. ___, Slip Op. at 8 (2010).

Nevertheless, independent claims 30 and 54 have been amended in a manner to overcome the rejection. Claims 31-53 were rejected as being dependent on allegedly non-statutory independent claim 30. Because claim 30 is drawn to statutory subject matter, remaining claims 31, 36, 38, and 40-53 also recite statutory subject matter. Claims 32-35, 37, and 39 have been cancelled and thus, the rejection of these claims is moot. Applicant respectfully requests that the rejection of claims 30, 31, 36, 38, and 40-54 under 35 U.S.C. § 101 be withdrawn.

Applicant respectfully traverses the rejection of claims 30, 31, 36, 38, and 40-55 as being unpatentable over *Hinkle* in view of *Excel97* and *Baker*, and claim 33 as being unpatentable over *Hinkle* in view of *Excel97*, *Baker*, and *Underwood*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01(III). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Amended independent claim 30 recites a combination including, for example:

assigning a second state to said selected invoices that satisfy the condition, wherein the second assigned state includes a second set of characters that are stored with the first set of characters in the data field of each selected electronic-invoice record; and

using the first state and the second state to control processing of the invoices.

Neither *Hinkle*, *Excel97*, *Baker*, nor *Underwood*, whether taken separately or in any proper combination, discloses or suggests at least these elements of claim 30. As conceded by the Examiner, neither *Hinkle* nor *Excel97* teaches “assigning a second state to said selected invoices and using at least one of the first state and the second state to control processing of the invoices.” Office Action, p. 4. The Office Action relies on *Baker* to overcome this deficiency of *Hinkle* and *Excel97*. However, this is not correct.

Baker discloses “[a]n automated administration system for providing state-based control of soft-labeled keys (SLKs) in a wireless terminal or other type of communication system terminal.” *Baker*, Abstract. Such a disclosure does not constitute “assigning, by using the processor, a second state to said selected invoices . . . and using the first state and second state to control processing of the invoices.” This is at least because as provided in *Baker*, a “state represents those events that are legitimate for the user.” *Baker*, col. 5, ll. 50-52. *Baker* fails to teach or suggest at least:

assigning a second state to said selected invoices that satisfy the condition, wherein the second assigned state includes a second set of characters that are stored with the first set of characters in the data field of each selected electronic-invoice record; and

using the first state and the second state to control processing of the invoices.

Moreover, combinations of *Hinkle*, *Excel97*, *Baker*, and *Underwood* do not teach or suggest that “the second assigned state includes a second set of characters that are stored with the first set of characters in the data field of each selected electronic-invoice record.” On pages 8 and 9 of the Office Action, the Examiner relies on *Underwood* to overcome this deficiency of *Hinkle*, *Excel97*, and *Baker*. This, however, is not correct.

As cited in the Office Action, *Underwood* discloses that to search for a specific record in a database, “click on the field containing the data to search by and then click on the Find [System Investigation Report] SIR button.” *Underwood*, col. 270, ll. 27-33. Such a disclosure does not constitute “the second assigned state includes a second set of characters that are stored with the first set of characters in the data field of each selected electronic-invoice record.” This is at least because *Underwood* teaches that the multiple types of information included in a system investigation report (SIR) are displayed in a plurality of fields. *Underwood*, col. 269, ll. 1-5. *Underwood* fails to teach or even suggest at least “the second assigned state includes a second set of characters that are stored with the first set of characters in the data field of each selected electronic-invoice record.”

For at least the reasons set forth above, the Office has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has

been established. The rejection of claim 30 under 35 U.S.C. § 103 as being obvious from *Hinkle* in view of *Excel97*, and *Baker* is thus improper and should be withdrawn.

Independent claims 54, and 55, while differing in their scope, each recite elements similar to those discussed above in relation to claim 30. Thus, for at least the reasons above, independent claims 54 and 55 are allowable over *Hinkle* in view of *Excel97*, *Baker*, and *Underwood*. Applicant respectfully requests the Examiner to withdraw the rejection of claims 54 and 55 under 35 U.S.C. § 103.

In its rejection of claims 31, 36, 38, and 40-53, the Office Action similarly relied on *Hinkle*, *Excel97*, *Baker*, and *Underwood*. But claims 31, 36, 38, and 40-53, each depend from independent claim 30, and thus include all elements thereof. As set forth above, neither *Hinkle*, *Excel97*, *Baker*, nor *Underwood* teaches or suggests at least "assigning, by using the processor, a second state to said selected invoices . . . wherein the second assigned state is characterized by a second set of characters which are stored with the first set of characters in said data field of the electronic invoice-record; and using the first state and second state to control processing of the invoices," as recited in independent claim 30. The rejections of dependent claims 31, 36, 38, and 40-53, under 35 U.S.C. § 103 are thus improper and should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and re-examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 30, 2010

By:

A handwritten signature in dark ink, appearing to read 'Philip J. Hoffmann', is written over a horizontal line.

Philip J. Hoffmann
Reg. No. 46,340